REMARKS

By this Preliminary Amendment, Applicants cancel claims 15-16, 20-21, and 24-26, without prejudice or disclaimer of the subject matter thereof. Applicants amend claims 1-9, 11-13, 17-19, 22, 23, and 27 to more appropriately define the present invention. Claims 1-14, 17-19, 22, 23, and 27 are currently pending in the application.

Applicants also amend the Title, the Specification, the Drawings, and the Abstract to bring the present continuation application into conformity with the respective parts of the parent application as amended during its prosecution.

In the Final Office Action, dated September 3, 2003, for the parent of the instant application, the Examiner rejected claims 1-4, 7, 9-10, 12, 18, 19, 22, 23, and 27 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,684,918 to Abecassis ("Abecassis"), rejected currently pending claims 1-7, 9, 10, 11-14, 17-19, 22, 23, and 27 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5, 261,820 to Slye et al. ("Slye") in view of Abecassis; and rejected claims 8 and 11 under 35 U.S.C. 103(a) as being unpatentable over Abecassis.

Applicants respectfully traverse the §102(b) rejection of claims 1-4, 7, 9-10, 12, 18-19, 22-23, and 27 as being anticipated by Abecassis for the following reasons. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. §102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. §2131 (8th Ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed.

Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131 (8th ed. 2001), p. 2100-69.

Regarding claim 1, Abecassis merely discloses a video on demand system which integrates video and communications services to a viewer (Abstract). Specifically, Abecassis discloses a video system wherein the delivery of video is automatically paused in response to the viewer accepting a call, and upon conclusion of the call, the video stream is automatically restarted at the point where it was placed on hold, or at some pre-defined amount of time prior to the pausing of the video (Abstract). Moreover, Abecassis discloses standard controls over prerecorded video sources, such as motion pictures or interactive advertisements, where a user may exercise various control options, such as pausing or altering the video transmission speed (col. 13, lines 59-67).

Conversely, Abecassis fails to disclose, at least, "a recording means for, while the game is progressing, progressively recording a historical state of the performance of the game for a predetermined duration of time" as recited in claim 1.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 1. Claims 2-4, 7, 9-10, 12, 18-19, 22, 23, and 27 depend from claim 1, and are allowable at least by virtue of their dependency from allowable claim 1.

Applicants respectfully traverse the §103(a) rejection of claims 1-7, 9-10, 11-14, 17-19, 22, 23, and 27 as being unpatentable over Slye in view of Abecassis because the Examiner failed to sustain a *prima facie* case of obviousness. In order to maintain a valid §103(a) rejection, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See

M.P.E.P. §2143.03 (8th ed. 2001).) Second, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in Applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001).)

Regarding the §103(a) rejection of claim 1, Slye merely teaches a computer simulation playback method which includes the steps of recording commands entered during the use of the simulation (Abstract). Specifically, Slye teaches a simulation which records commands entered by a user while the simulation is being played. The commands are recorded simply by saving them in memory, such as a disk drive. The initial settings of the simulation may also be saved. The simulation can then be played back by the user. (See col. 2, lines 55-66.)

Conversely, Slye fails to teach or suggest, at least, "a recording means for, while the game is progressing, progressively recording a historical state of the performance of the game for a predetermined duration of time" as recited in claim 1. (emphasis added.)

in this respect, Abecassis fails to cure the deficiencies of Slye, for the same reasons provided above in response to the §102(b) rejection of claim 1 over Abecassis.

Neither Sly or Abecassis, taken either separately or in combination, teach or suggest at least, as recited in claim 1, "a recording means for, while the game is progressing, progressively recording a historical state of the performance of the game for a predetermined duration of time."

Accordingly, Applicants request the Examiner withdraw the 103(a) rejection of claim 1. Claims 2-7, 9-10, 11-14, 17-19, 22, 23, and 27 depend from claim 1, and are allowable at least by virtue of their dependency from allowable claim 1.

Applicants respectfully traverse the rejection of claims 8 and 11 under 35 U.S.C. 103(a) as unpatentable over Slye. By virtue of their dependency from claim 1, claims 8 and 11 incorporate all the features as recited in allowable claim 1. As presented above in the arguments for the §103(a) rejection of claim 1 over Abecassis in view of Sly, Sly fails to teach or suggest at least the recording means as recited in claim 1.

Furthermore, the Examiner appears to be taking Office Notice by taking the position that it is "notoriously well known within gaming systems at the time the invention was made to incorporate a countdown mechanism, after a player has not finished the game in time, to start wherein the player has time to resume the current position within the video game." (See Final Office Action, page 6, lines 9-12.) The Examiner is respectfully reminded of the provisions of MPEP § 2144.03, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999) and In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principle evidence upon which a rejection is based. Accordingly, Applicant traverses the Official Notice and requests that the Examiner either cite a competent prior art reference in substantiation of these conclusions, supply a personal affidavit supporting the Examiner's allegation, or else withdraw the rejection.

In view of the foregoing amendments and remarks, Applicants respectfully requests the examination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this paper and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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for Reg. No. 31,744